UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,294	05/31/2006	Moreno Naldoni	U 015959-0	2073

140 7590 02/19/2008

LADAS & PARRY LLP
26 WEST 61ST STREET
NEW YORK, NY 10023

EXAMINER	
MATTER, KRISTEN CLARETTE	
ART UNIT	PAPER NUMBER
3771	
MAIL DATE	DELIVERY MODE
02/19/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/552,294	NALDONI, MORENO	
	Examiner	Art Unit	
	KRISTEN C. MATTER	3771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 December 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,9,10 and 13-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,9,10 and 13-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This Action is in response to the amendment filed on 12/26/2007. Claims 1, 10, and 14 have been amended, claims 2-8, 11, and 12 have been cancelled, and claims 15 and 16 have been added. Currently, claims 1, 9, 10, and 13-16 are pending in the instant application.

Claim Objections

Claim 1 is objected to because of the following informalities: in the last line, "each has two projections" should be changed to --each have two projections-- for proper subject verb agreement. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Frenkel et al. (DE 4304091 A1). Frenkel discloses a skin massage device comprising: a handset (fig. 1) connected to a machine body; said handset in turn comprising a chamber closed by a deformable membrane 3 which at least partly adheres to a patient's skin by virtue of a vacuum generated in said chamber by a vacuum generating device 5 (fig. 1); means for producing a variable vacuum in said chamber 4 to deform said membrane 3 and so lift, fold, compress, and smooth the patient's skin as to perform the massage cycle set by the operator; wherein said membrane 3 has

projections and recesses (fig. 1) to assist the formation of folds of tissue on which to exert a given pressure to perform the desired massage; wherein said membrane 3 varies in thickness so as to yield differently at different points (fig. 2); wherein said membrane 3 comprises a central portion having at least one hole (fig. 2) for lifting a portion of skin ; and as best understood, two lateral portions (at the side edges in fig. 2); wherein said lateral portions are thicker than said central portion (fig. 2); wherein said lateral portions each have two projections (next to 3a and 3b, fig. 2); wherein said handset has means for activating and programming said device (fig. 1); and as best understood, wherein the means are programmable to perform pulsating treatment cycles of a patient's skin as determined by an operator (fig. 1).

Claims 1, 9, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Thompson et al. (US 1,460,927). Thompson et al. discloses a skin massage device comprising a body connected to a handset (2) that comprises a chamber (see Figure 1) closed by a deformable membrane (4) which at least partially adheres to a patient's skin by virtue of a vacuum generated in said chamber by a vacuum generating device (column 1, lines 35-43), wherein the device comprises means (11) for producing variable vacuum in said chamber to deform said membrane to some extent thereby lifting, folding, compressing, and smoothing the patient's skin, wherein said membrane comprises a central portion (area referenced by reference character 5 in Figure 1) having at least one hole (9) for lifting a portion of the skin and two lateral portions (the rest of the diaphragm seen in Figure 1) thicker than said central portion which are moveable by the vacuum generated inside the chamber to some extent and which each have two projections (6) with through holes (8). Thompson et al. discloses the diaphragm as a hard rubber, but rubber

inherently deforms to some extent. In addition, it appears as though the membrane merely has to be relatively harder than the rest of the body for the device to create the desired vacuum. The device is disposable because a user can inherently throw it away, thus disposing of the membrane.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Frenkel in view of Jacobs (5,665,053). Frenkel discloses the claimed invention including a collar around a central through hole (see Figure 1 where membrane 3 attaches to the central bore area 2b) except for an ultrasound emitting device being fixed to said collar. However, Jacobs teaches an endermology device comprising a vacuum source and an ultrasound generator for applying ultrasonic wave energy to increase the breakdown of subcutaneous fatty tissue (col. 1, lines 30-67). The ultrasound generator can be attached within the housing and adjacent to and surrounding the center of the user interface (see figure 3B elements 40c and 40b and column 1, lines 49-51). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Frenkel's reference to include an ultrasound emitting device attached to a central internal part of the housing (i.e., the collar of Frenkel), as suggested and taught by Jacobs, for the purpose of providing means to perform endermology that

utilizes ultrasonic wave energy to increase the breakdown of subcutaneous fatty tissue (col. 1, lines 30-67). In addition, it appears as though the device of Frenkel would perform equally well with an ultrasound generator attached to the collar.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al. as applied to claims 1, 9, and 15 above, and further in view of Jacobs. Thompson et al. discloses the claimed invention except for an ultrasound emitting device being housed in said central through hole (9). However, Jacobs teaches an endermology device comprising a vacuum source and an ultrasound generator for applying ultrasonic wave energy to increase the breakdown of subcutaneous fatty tissue (col. 1, lines 30-67). The ultrasound generator can be attached within the housing and adjacent to and surrounding the center of the user interface (see figure 3B elements 40c and 40b and column 1, lines 49-51). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Thompson et al.'s reference to include an ultrasound emitting device in said central through hole, as suggested and taught by Jacobs, for the purpose of providing means to perform endermology that utilizes ultrasonic wave energy to increase the breakdown of subcutaneous fatty tissue (col. 1, lines 30-67). In addition, it appears as though the device of Thompson et al. would perform equally well with an ultrasound emitting device.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al. as applied to claims 1, 9, and 15 above, and further in view of Frenkel. Thompson et al. is silent as a means for activating and programming the device to perform

pulsating treatment cycles. However, Frenkel discloses a skin massaging device that uses a controller for activating and programming a vacuum generating device and as best understood, wherein the means are programmable to perform pulsating treatment cycles of a patient's skin as determined by an operator (fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have replaced the manual vacuum generating device of Thompson with a programmable vacuum generating device as taught by Frenkel for allowing a user to automatically produce the variable vacuum cycle for treating the skin.

Response to Arguments

Applicant's arguments filed 12/26/2007 have been fully considered but they are not persuasive.

In response to applicant's arguments that the lateral portions of Frenkel do not have holes, examiner points out that this limitation is not included in independent claim 1 nor any of the claims upon which Frenkel reads.

In response to applicant's arguments involving Schatz, examiner points out that this argument is also not persuasive, but after reconsideration, examiner does not believe the holes (4a) of Schatz can actually be considered holes in the membrane (as recited in claim 1) because they are referenced as being holes in the nozzle body (4), not in the membrane (3).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Milstein et al. is cited to show another skin massaging device with through holes.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTEN C. MATTER whose telephone number is (571)272-5270. The examiner can normally be reached on Monday - Friday 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kristen C. Matter/
Examiner, Art Unit 3771

/Justine R Yu/

Supervisory Patent Examiner, Art Unit 3771